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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

HSU, G

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/122,576

Applicant(s)

Siev et al.

Examiner

Grace Hsu, Ph.D.

Group Art Unit

1627



☒ Responsive to communication(s) filed on May 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-27 and 29-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-27 and 29-31 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Examiner at Jyothsna.Venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. Claims 1-27 and 29-31 are pending in the instant application.
2. The Response to Restriction Requirement received on May 9, 2000 was entered as Paper No. 10.
3. Applicants' election of Group I, traverse, claims 1-27 and 29-31, for examination purposes, is acknowledged.

Applicants' traversal was made on that [1] an election had been made on the record of Group I, claims 1-27, 29-32, 34-76, 78-101 and 103-106, as set forth in the January 21, 2000 Response; and that [2] that no serious search burden exists as the claimed invention included the same generically patentable concepts.

Applicants' arguments are found non-persuasive. The current Examiner maintains that: [1] Group I as elected in the January 21, 2000 Response contained different inventive concepts directed to different products and uses; such that [2] an undue search burden exists, because divergent searches requirements are required for the inventions encompassed by that group,

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because those inventions are classified in different classification and subclassifications. The requirement is still deemed proper and is therefore made **FINAL**.

4. Claims 32, 37-48, 54-76, 78-101 and 103-116 are withdrawn from further consideration by the Examiner under 37 CFR 1.142(b), as being drawn to non-elected inventions, the requirement traversed in Paper No. 10.

5. In light of applicants May 9, 2000 election of Group I, claims 1-27 and 29-31, a new restriction requirement is set forth for reasons below.

Election/Restriction

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1, 6-19 and 30-31, drawn to a method for the production of a derivatized resin represented by formula (I), $R_4-NH-(C=X)-Y-Z-SS$, is prepared by a process comprising steps (I) and (ii), wherein step (I) involves reacting a **starting material (C)**, $R_1-(C=X)-Y-Z-SS$, with a **reactant of formula (D)**, R_4-NH_2 , classified in class 436, subclass 85 and in other classes/ subclasses, which will vary depending on the choice of substituents of each starting material, reagent and products.
 - II. Claim 2 and 5, drawn to a method for making aldehyde derived products using a derivatized resin of formula (I), which further comprises reacting an aldehyde to form an immobilized aldehyde and cleaving the product, classified in class 436, subclass 518 and in other classes/ subclasses, which will vary depending on the choice of substituents of each starting material, reagent and products.
 - III. Claim 2 and 5, drawn to a method for making ketoamide products using a derivatized resin of formula (I), which further comprises reacting ketoamide and cleaving the product, classified in class 436, subclass 518 and in other classes/ subclasses, which will vary depending on the choice of substituents of each starting material, reagent and products.

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- IV. Claims 2-4 and 29, drawn to a method for making different libraries using a derivatized resin of formula (I), further comprising the step of performing solid phase chemistry on said immobilized aldehyde, in class 436, subclass 518 and in other classes/ subclasses , which will vary depending on the choice of substituents of each starting material, reagent and products.
 - V. Claims 2-4 and 29, drawn to a method for making different libraries using a derivatized resin of formula (I), further comprising the step of performing solid phase chemistry on said immobilized ketoamide in class 436, subclass 518 and in other classes/ subclasses , which will vary depending on the choice of substituents of each starting material, reagent and products.
 - VI. Claims 20-21, drawn to a method for making products/libraries using a semicarbazone derivatized resin of formula (I), further comprising the step of deprotecting amino terminal nitrogen and linking additional residues/analogs, i.e., performing solid phase chemistry, in class 436, subclass 518 and in other classes/ subclasses , which will vary depending on the choice of substituents of each starting material, reagent and products.
 - VII. Claims 1, 15-16 and 22, drawn to a method for the production of a semicarbazone derivatized resin represented by formula (II), in class 436, subclass 85+ and in other classes/ subclasses , which will vary depending on the choice of substituents of each starting material, reagent and products.
 - VIII. Claims 1, 15-16 and 23-27, drawn to a method for producing a semicarbazone derivatized resin of formula (III), in class 436, subclass 518 and in other classes/ subclasses , which will vary depending on the choice of substituents of each starting material, reagent and products.
7. The inventions are distinct, each from the other, because of the following reasons:
8. Groups I-VII represent separate and distinct inventions. Groups I-VII are drawn to different methods or process (which are directed to different procedures for transforming or reducing a chemical substance(s) for different purposes, use different materials, recite different method steps for the preparation of different product or lead to different final results). Therefore,

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Groups I-VII have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches.

9. Groups I and VII-VIII and Groups II-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product resins of Groups I and VII-VIII may be used for different purposes, in different methods other than those defined by those of Groups II-VI and the products of Groups II-VI can be made by alternate methods other than use of resins defined by Groups I and VII-VIII.

10. These inventions are distinct for the reasons above and have acquired a separate status in the art because of their recognized divergent subject matter and/or shown by their different classifications. While some of the aforementioned groups are classified under an identical class/sub-class, the corresponding non-patent literature search remains unaffected. Each of the identified groups may require different searches. For example, methods and products groups require different searches. Therefore, restriction for examination purposes as indicated is proper.

11. This application contains claims directed to the following patentably distinct species of the claimed invention.

12. Applicants are advised that a reply to this requirement must include **an identification of each species in claims 1-27 and 29-31** that is elected consonant with this requirement, and a

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listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Each of the species identified in claims above represents patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

For species identification and search purposes, applicants should provide the chemical structure of each component species, reactant and/or reagents used and corresponding library product(s) formed via solid phase synthesis procedures of the claimed invention (i.e., for example., with regard to specific resin species and species as those identified in claim 3, 20, 23, 25 and 29), wherein the specific chemical formula substituents of the aforementioned compounds are defined either by picture or by expressing the species in terms of the variables of the formula.

Each of the species encompassed by the claimed invention represent patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

13. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

14. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Conclusion

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D. whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 6:00 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jyothsna Venkat, Ph.D., may be reached at (703) 308-2439. The fax number assigned to Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

Grace C. Hsu, Ph.D., J.D.
July 17, 2000

BENNETT CELSA
PRIMARY EXAMINER
